

Appl. No. 09/529,575
Docket No. 7042RL+
Response dated October 3, 2008
Reply to Office Action mailed on July 8, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 31, 32, 36, 42-44, 46, 48, and 52-53 are pending in the present application. No additional claims fee is believed to be due.

Claim 31 has been amended to more clearly define the article in accordance with the teachings of the specification, for example, at page 28.

Rejection Under 35 USC §103(a) Over Roe in view of Caldwell

Claims 31, 32, 36, 42-44, 46, 48, and 52-53 have been rejected under 35 USC §103(a) as being unpatentable over Roe (USPN 5,607,760) in view of Caldwell (USPN 5,874,164).

The Office Action asserted that Roe discloses all aspects of the claimed invention with the exception of the protease inhibitor being pentamidine and present in the amount of 0.0001-30% by weight. The Office Action also asserts that Caldwell teaches the application of a protease inhibitor to the topsheet of an absorbent article. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of invention to provide the lotion of Roe with pentamidine, as taught by Caldwell, to yield the predictable result of providing the lotion with antimicrobial activity.

Under MPEP 2142, the Office bears the burden of factually supporting any *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). If the Office does not prove a *prima facie* of unpatentability, then without more, the Applicant is entitled to the grant of the patent. See in re *Oetiker*, 977 F.2d 1443.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must meet three basic criteria. First, there must be some suggestion or motivation, either in the

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cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants respectfully traverse this rejection because the Office Action fails to establish a *prima facie* case of obviousness.

First, neither Roe nor Caldwell teach or suggest Applicants' claimed concentration of protease inhibitors. Second, neither Roe nor Caldwell teach or suggest the use of 4-(2-aminoethyl)-benzenesulfonylfluoride hydrochloride or hexamidine, as a protease inhibitor having an IC₅₀ of about 500 μM or less, as required by independent claim 31. The Office has failed to consider the full text of MPEP §2144.05 and the case law cited therein. The Office fails to point to a teaching within Roe or Caldwell that recognizes that the amount of protease inhibitor is a "results-effective variable" as required by *In re Antoine*, 195 USPQ 6, 8, 9 (CCPA 1977). Instead, the Office relies on Caldwell's disclosure of pentamidine in general as meeting Applicants' lower threshold of 0.0001% by weight and then the reference's mention of coating a surface as an implication of the fact that such a coating would not result in a protease inhibitor concentration of no more than 30% by weight. Applicants submit that this implied presumption is insufficient to render the present claims obvious since there is no express disclosure of the claimed protease inhibitors or the claimed range thereof.

References relied upon to support a rejection under 35 U.S.C. 103(a) must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Because the cited combination fails to teach all of the claim limitations of independent Claim 31, the Office Action has not established a *prima facie* case of obviousness and has not placed the presently claimed disposable wearable article in the possession of the public. Since Claims 32, 36, 42-44, 46, 48, and 52-53 depend directly or indirectly from Claim 31, the cited combination also fails to teach all of their claim limitations. Therefore, Applicants assert that Claims 32, 36, 42-44,

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46, 48, and 52-53 are nonobvious over the cited combination and are in condition for allowance.

Conclusion

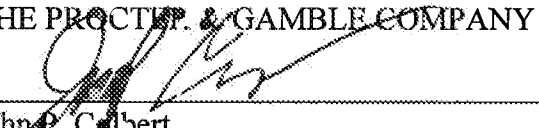
In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 103. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of Claims 31, 32, 36, 42-44, 46, 48, and 52-53 is respectfully requested.

Respectfully submitted,

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